

REMARKS

Claims 1-3 and 5-23 are pending and at issue in the present application. Claim amendments and remarks are presented herein. Entry and consideration of these amendments are respectfully requested.

Claims 1 and 15 stand rejected under 35 U.S.C. §103(a) as allegedly being obvious over Payson, et al., U.S. Patent No. 5,794,789 ("Payson"). Claims 1-38 stand rejected under 35 U.S.C. §103(a) as allegedly being obvious over Boyd, et al., U.S. Patent No. 6,208,908 ("Boyd"). By way of this amendment claim 4 has been canceled, and claim 1 has been amended to incorporate original claim 4. Claims 6, 10, and 15 have been amended merely to correct a grammatical error.

Claim 1 is Allowable.

Claim 1 recites a dumping station including, *inter alia*, a bin, a releasable latch positioned to retain the bin in a pick mode, and a collection area comprising a conveyor, wherein a processor is programmed to generate a release signal as a selected area of the conveyor passes the dumping station.

By incorporating the subject matter of original claim 4 into amended claim 1, claim 1 is now allowable over Payson. Original claim 4 was not rejected over Payson. Accordingly, the rejection of claim 1 based on Payson must be withdrawn.

With regard to the second ground of rejection, claim 1 is also allowable over Boyd.¹ Boyd does not teach or suggest a bin adapted to discharge articles on a conveyor. The office action asserts that "moving the dumping station apparatus along a conveyor or moving the conveyor along towards a stationary dumping station is considered to be functional

¹ The first sentence of paragraph 5 of the office action (page 4) indicates that claims 1-38 are unpatentable over Boyd. The subsequent sentence states that "Payson discloses the following." The reference numerals identified in the body of the rejection, however, appear to match those of Boyd. Applicant assumes that the reference to "Payson" was inadvertent, and instead should have read "Boyd." For the purposes of this response, Applicant addresses this rejection as asserting only Boyd, and not Payson or a combination of the two. If this is incorrect, Applicant respectfully requests that a further, non-final office action be used clarifying the basis for this rejection.

equivalents of each other" (noting column 3 lines 65-67 and column 4, lines 1-19).

Applicants strongly traverse this rejection.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion to modify the reference. Second, there must be a reasonable expectation of success. Finally, the prior art reference must teach or suggest all the claim limitations. See MPEP §2143. "The **initial burden is on the examiner** to provide some suggestion of the desirability of doing what the inventor has done." *Id.* (emphasis added).

The office action has failed to meet its burden because the prior art reference does not suggest a dump station including the structural elements of a bin and a conveyor with the bin adapted to dump articles onto a conveyor. Boyd only teaches that the bins or receptacles 12 are towed along by a conveyor to the desired dump stations. The text cited by the office action supports this: "The conveyor system 14 comprises a track 20 that transports the receptacles 12 through the system 10... Other means for transporting the receptacles 12 may be used in keeping with the present invention. As a few examples, belt conveyors, overhead conveyors..." Col. 3, lines 66-67, col. 4, lines 9-11.

Thus, Boyd only discloses a distributive system in which articles from one location are loaded onto a receptacle and the receptacle can be conveyed to a desired location. There is no suggestion for the receptacle of Boyd to deliver the articles to a further conveyor, as is recited in claim 1. Moreover, at not point does Boyd suggest that the receptacle may be stationary, let alone teach that moving the receptacle along the conveyor is "functionally equivalent" to moving the conveyor toward a stationary receptacle. Changing the structure of Boyd as suggested would defeat the purpose of the movable receptacles of Boyd, which are meant to transport entire customer orders from article dispensing stations 102 to pack stations 16. If a moving conveyor and a stationary receptacle were used, it is not seen how Boyd would collect the desired products from the desired dispensing stations 102 and deliver them to the desired pack station 16, as is possible with a moving receptacle with a selectively openable door.

The rejection based on Boyd further fails to disclose or suggest each structural element of claim 1. Instead, the office action argues that Boyd discloses the "functional equivalent" to the claimed dumping station. The focus of the inquiry should be whether Boyd teaches or suggests the specific structural elements recited in the claims. If all that would be

required is functional equivalency to render a structural claim obvious, as the office action suggests, then recited structure would have no patentable weight. Once a first product performs a certain function, any second product that performs a similar function, no matter how different the structure, no matter how faster, cheaper, or better it performs, would be obvious in view of the first. Regardless, as noted above, Boyd fails to teach any such functional equivalence. Because Boyd does not suggest the structural elements of a bin having a dump mode in which articles in the bin are discharged onto a conveyor, claim 1 is not obvious over Boyd.

Accordingly, independent claim 1 is allowable over the cited references. Further, dependent claims 2, 3, and 5-14 depending from claim 1 are also allowable.

Claim 15 is allowable.

Claim 15 recites a dump station including, *inter alia*, a support and a bin pivotably mounted to the support. Payson discloses a semi-automated integrated sort rack. The office action alleges that Payson discloses a bin 43 (see, e.g., Figs. 10 and 12). However, the office action does not allege in any form that Payson teaches or suggests a support and that the bin 43 is pivotally mounted to the support, as specifically recited in claim 15. For this reason alone, the office action has not made a *prima facie* case of obviousness.

Further, there is no teaching or suggestion in Payson that the bin 43 is pivotably mounted on a support. The bin 43 of Payson is a passive receptacle that receives the packages after they have slid down the chute. After the bin 43 is filled, a user retrieves the bin 43 and empties it according to his or her needs. Because there is no reason to make the bin 43 pivotable, there is no suggestion to do so, and this rejection should be withdrawn.

Turning to the second ground of rejection, there is also no teaching or suggestion in Boyd for a bin that is pivotably mounted on a support. The office action asserts that "the Applicant's dump mechanism, pivotally mounted, is construed to be amongst the numerous methods well-known to those ordinarily skilled in the art to accomplish discharging of articles." While the office action cites Col. 7, lines 25-30 for support, this portion of the text makes no mention of a bin with the claimed structure. The only structure taught by the cited text is a bin with sidewalls moveable relative to the bin itself that allow the articles to be discharged. In these structures, the bin is stationary while the walls of the bin move. Thus,

there is no teaching or suggestion in Boyd of a dump station with a support and a bin pivotably mounted on the support.

In this case, the examiner has not provided the proper language to have taken official notice. If official notice is taken in the next office action, it would be a new rejection. Further, if official notice is taken in the next office action, the applicants will traverse and require citation to a published reference showing a dump station with, *inter alia*, a bin pivotably attached to a support.

Accordingly, the rejections of claim 15 are improper, and claim 15 allowable over the cited references. Furthermore, claims 16-23, which depend directly or indirectly from claim 15, are also allowable.

Dependent Claims

Several of the dependent claims will be addressed separately, because the rejections are improper. Claims 2 and 16 stand rejected as being allegedly obvious in view of Boyd because the recited electromagnetic latch is the "functional equivalent" of the latch disclosed in Boyd. Again, the proper inquiry is a comparison to the structure taught by the reference and the claimed structure. The latch in Boyd cannot render all latches, no matter how new or different, alone or in combination with other features, obvious simply because they perform an equivalent function. There is no assertion in the office action that it was known or suggested to use an electromagnetic releasable latch on a bin in a dump station.

With regard to claims 7 and 22, there is no teaching or suggestion in Boyd to place a weight on the bin to shift the center of gravity. With regard to claims 8 and 17, there is no suggestion in Boyd for a dump pedestal or pick pedestal that engage the bin in the dump mode and the pick mode, respectively. The office action seems to assert that because Boyd includes language that other configurations are possible, all configurations are anticipated by or obvious in view of Boyd. This is improper, as the correct inquiry is whether Boyd suggests the specific claimed configuration. There is no purpose and therefore no suggestion to add a weight to the receptacle of Boyd, nor is there any purpose and therefore no suggestion to add the recited pedestals, because the receptacle disclosed in Boyd does not pivot.

Claim 10 recites a front flap and a rear flap each pivotably connected to the bin and connected to each other via a cable. There is absolutely no teaching in Boyd of such structure, nor is there any suggestion to create such a structure. The office action again recites the same general language that other configurations are possible. But such language does not suggest flaps connected by a cable.

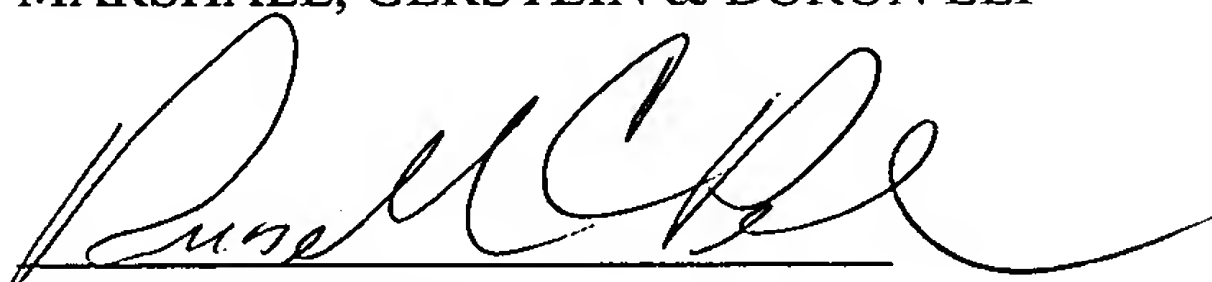
These arguments to specific dependent claims are merely representative, and arguments to other dependent claims are reserved for a response to a later office action.

CONCLUSION

It is submitted that the present application is in good and proper form for allowance. A favorable action on the part of the Examiner is respectfully solicited. If, in the opinion of the Examiner a telephone conference would expedite prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,
MARSHALL, GERSTEIN & BORUN LLP

By:



Russell C. Petersen,
Reg. No. 53,457
Attorneys for Applicants
6300 Sears Tower
233 South Wacker Drive
Chicago, Illinois 60606-6402
(312) 474-6300

April 30, 2004